

Remarks

The present amendment is being filed in response to the Official Action mailed on May 2, 2006. The Official Action acknowledged Applicant's election of specie A, claims 1-3, 5, 7, 8, 10-13, 16, 27-29, 31, 33, 34, 38-40 and 42. Claims 4, 6, 9, 14, 15, 17-26, 30, 32, 35-37 and 41 were withdrawn from further consideration. Claims 1-3, 5, 27-29 and 31 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kaiwa et al. U.S. Patent No. 6,490,436 ("Kaiwa"). Claims 7, 8, 10-13, 16, 33, 34, 38-40 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakeshita U.S. Patent No. 6,775,487 ("Kakeshita") in view of Ito et al. U.S. Patent No. 7,027,755 ("Ito") and Kaiwa. These grounds of rejection are addressed below.

Claims 1, 10 and 34 have been amended to be more clear and distinct. Claims 7, 8, 27-33 and 42 have been canceled without prejudice. Claims 1-3, 5, 10-13, 16, 34 and 38-40 are presently pending, with claims 4, 6, 9, 14, 15, 17-26, 35-37 and 41 being withdrawn from consideration.

The Art Rejections

As addressed below, Kaiwa, Kakeshita and Ito do not support the Official Action's reading of them. Further, Applicant does not acquiesce in the analysis of the relied upon art made by the Official Action and believe that these rejections should be withdrawn.

Amended claim 1 of the present invention reads as follows:

1. An electronic circuit casing holding an electronic circuit adapted for communication with an imaging device, comprising:
 - a plurality of walls forming the casing holding the electronic circuit; and
 - at least one structure formed in at least one of the plurality of walls to facilitate removal of the casing from a replaceable imaging cartridge when the casing is attached to the replaceable imaging cartridge.

Kaiwa describes a battery pack removing device for a portable telephone 10. A portable telephone 10 includes a battery pack 50 having a recess 61 and a protrusion 70. A slide pawl 21 of the telephone 10 engages the recess 61 to hold the battery pack 50 in place. To remove the battery pack of Kaiwa, a slide protrusion 22 of the telephone 10 is brought into contact with the protrusion 70 to push the battery pack 50 upward for removal. Ito and Kakeshita describe typical prior printer cartridges having attached

memory elements. The memory element of Ito is indicated to be “removably connected” to the cartridge.

The Official Action states that it would be obvious to combine Kakeshita and Ito with Kaiwa “for easy removal of the casing.” Applicant respectfully disagrees. “[E]asy removal of the casing” is one of the advantages of the present invention. It is only in hindsight, after seeing the claimed invention, that the one could combine Kakeshita and Ito with Kaiwa. This is improper under the law of the Federal Circuit, which has stated that “[w]hen prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.” Uniroyal, Inc. v. Rudkin Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988), cert. den., 109 S. Ct. 75, 102 L.Ed. 2d 51 (1988); quoting Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1132 227 U.S.P.Q. 543, 535 (Fed. Cir. 1985). Furthermore, “[i]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.” Uniroyal, 837 F.2d at 1051, 5 U.S.P.Q. 2d at 1438. Similarly, “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” In re Laskowski, 871 F.2d 115, 117 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989), quoting In re Gorgon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). No such suggestion is found here.

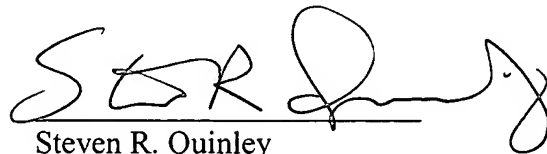
Moreover, Kawai is simply nonanalogous art. There is nothing in the nature of the problem addressed by the present invention that would lead a person of ordinary skill in the art of printer cartridge design to look to the art of portable telephones. Printer cartridges and portable telephones are entirely different fields. See, generally, In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). As Ito and Kakeshita, standing alone or together, do not teach or render obvious the techniques of the present invention, independent claims 1, 10 and 34, and the claims depending therefrom, are in order for allowance.

Additionally, amended claim 34 includes “applying a force, by an external tool, to at least one structure formed in an electronic circuit casing, said casing being attached to said printer cartridge, the at least one structure adapted for engagement with the external

tool, the external tool not attached to the printer cartridge....” (emphasis added) As described above, the battery pack 50 of Kaiwi is removed by a slide protrusion 22 which is attached to the portable telephone 10. In contrast, the electronic circuit casing of claim 12 requires an external tool not attached to the printer cartridge. Clearly, Kawai does not teach the techniques of claim 34 and does not cure the failings of Ito and Kakeshita as references.

All of the pending claims appearing to be in order for allowance, prompt allowance of the present application is requested. Any questions regarding this application may be raised by telephone with the undersigned if it is considered that processing of this application will be expedited thereby.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S R Quinley', written over a horizontal line.

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